

**REMARKS**

Claims 28-41 and 43-55 are pending. By this Amendment, claims 28 and 29 are amended. No new matter is added by any of these amendments.

Applicant appreciates the courtesies extended to Applicant's representative by Examiner Fischer during the April 27, 2004 telephone interview.

Reconsideration based on the following remarks is respectfully requested.

**I. The Claims Satisfy the Requirements under 35 U.S.C. §112, second paragraph**

The Office Action rejects claims 28-41 and 43-55 under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 28 has been amended to obviate this rejection in view of the Examiner's helpful comments. Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is respectfully requested.

**II. Claim 29 Satisfies the Requirements under 35 U.S.C. §112, fourth paragraph**

The Office Action rejects claims 29 under 35 U.S.C. §112, fourth paragraph, as including every limitation of the claim from which it depends. Claim 29 has been amended to obviate this rejection with support found in the specification at page 16, lines 16-23. Withdrawal of the rejection under 35 U.S.C. §112, fourth paragraph is respectfully requested.

**III. Claims 28-41 and 43-55 Define Patentable Subject Matter**

The Office Action rejects claims 28-41 and 43-55 under 35 U.S.C. §102(e) over U.S. Patent 6,129,274 to Suzuki (Suzuki '274). This rejection is respectfully traversed.

Suzuki '274 does not teach or suggest a data providing method for providing a purchaser with first data for which to make a purchase request from a data providing system having a data delivery portion for delivering the first data to the purchaser and a data intermediate portion connected with the data delivery portion via a communication line for intermediating between the data delivery portion and the purchaser, the purchaser having a purchaser rewritable record medium for recording the first data, second data and third data,

the second data representing an identification information of the purchaser, the third data being recorded on the purchaser rewritable record medium as purchaser third data and registered in the data providing system as registered third data, the method including, *inter alia*, retrieving the registered third data from the data providing system based on the second data recorded in the purchaser rewritable record medium, when the purchaser makes the purchase request of the first data, performing an accounting operation that provides the purchaser with the first data when the registered third data are matched with the purchaser third data, the accounting operation producing additional third data that represent the purchase information for purchasing the first data, recording the first data and the additional third data in the purchaser rewritable medium after the accounting operation is performed, and registering the additional third data in the data providing system, after the accounting operation is performed, as recited in claim 28.

Instead, Suzuki '274 discloses a system for updating transaction history without intervention of a store platform computer. In particular, Suzuki '274 teaches use of a customer-maintained machine-readable smart card 10 for receiving and recording data from a point-of-sale terminal 12 or stand-alone terminal 30 to update purchase transactions of general merchandise. The data are recorded in a static information storage area 70 of the smart card 10. See col. 8, line 54 – col. 10, line 36 and Figs. 1-2 of Suzuki '274.

Because Suzuki '274 neither teaches nor suggests recording the first data (*i.e.*, the recordable purchased good) in the purchaser rewritable record medium, Suzuki '274 fails to anticipate at least this feature in Applicant's claim 28. Further, the typical purchase lacks both means and utility for reading the IC, while a rewritable record medium is commonly used in conjunction with personal computer equipment, commonly available.

Rather, Suzuki '274 provides a system for awarding coupons to a customer. Because this purpose of Suzuki '274 has no relation to recording the first data (*e.g.*, uploading

purchased software), Suzuki '274 provides no motivation to modify teachings to achieve Applicant's claimed features. Hence, Applicant's claimed features are also not obvious in view of Suzuki '274. In addition, Suzuki '274 fails to specify a sequential order or matching condition for updating purchase transactions. The Office Action has not established that Suzuki '274 teaches every feature of Applicant's claims, nor shown a sufficient motivation to modify, or a *prima facie* case of obviousness. Thus Suzuki '274 neither anticipates nor renders obvious at least these features in Applicant's claim 28. These arguments apply by extension to claims 29-41 and 43-55.

The Office Action further rejects claims 28-41 and 43-55 under 35 U.S.C. §103(a) over U.S. Patent 5,267,171 to Suzuki *et al.* (Suzuki '171) in view of U.S. Patent 5,857,020 to Peterson Jr. (Peterson), or alternatively over Suzuki '274. These rejections are respectfully traversed.

Suzuki '171 and Peterson and/or Suzuki '274 do not teach or suggest a data providing method for providing a purchaser with first data for which to make a purchase request from a data providing system having a data delivery portion for delivering the first data to the purchaser and a data intermediate portion connected with the data delivery portion via a communication line for intermediating between the data delivery portion and the purchaser, the purchaser having a purchaser rewritable record medium for recording the first data, second data and third data, the second data representing an identification information of the purchaser, the third data being recorded on the purchaser rewritable record medium as purchaser third data and registered in the data providing system as registered third data, the method including, *inter alia*, retrieving the registered third data from the data providing system based on the second data recorded in the purchaser rewritable record medium, when the purchaser makes the purchase request of the first data, performing an accounting operation that provides the purchaser with the first data when the registered third data are

matched with the purchaser third data, the accounting operation producing additional third data that represent the purchase information for purchasing the first data, recording the first data and the additional third data in the purchaser rewritable medium after the accounting operation is performed, and registering the additional third data in the data providing system, after the accounting operation is performed, as recited in claim 28.

Instead, Suzuki '171 discloses a vending machine for computer software. In particular, Suzuki '171 teaches software vending machine 3 with a memory 13, and a CPU 10 connected to a host computer 1 through communication lines 2. The machine 3 of Suzuki '171 further includes a data reading/writing section 18 for retrieving and storing data on an ID card 20. Suzuki '171 further teaches that the card 20 stores the latest utilization date (information LU), purchase date (information LV), identification (information ID), software category (information IJ) and designated models (information IM). See col. 2, lines 38-58, col. 3, lines 9-31, and Figs. 1, 2 and 7 of Suzuki '171.

There is no teaching or suggestion that Suzuki '171 provides for recording the first (or primary) data (*i.e.*, software to be purchased) onto the purchaser's rewritable record medium, as recited in Applicant's claims. Rather, Suzuki '171 teaches that the CPU 10 causes a software selling section 16 to write the purchased software onto a floppy disk provided by the machine 3 and discharged to the purchaser. See col. 4, lines 55-63 and Fig. 2 of Suzuki '171. Thus, Suzuki '171 teaches away from Applicant's claimed features.

Peterson does not compensate for the deficiencies of Suzuki '171 outlined above for claim 28. Nor does Peterson teach, disclose or suggest the additional features recited in claims 29-41 and 43-55. Instead, Peterson discloses a system for providing timed-available data based on authorization. In particular, Peterson teaches a storage medium 10 with a medium reader 12 coupled to a controller 14 with an authorization center 16. Peterson further teaches that upon authorization the data are unlocked (by decryption) from the

controller 14 to the reader 12 and accessed at output 20. See col. 3, line 63 – col. 4, line 15 and Fig. 1 of Peterson.

Also, Suzuki '274 does not compensate for the deficiencies of Suzuki '171, or alternatively Peterson. Nor does Suzuki '274 teach, disclose or suggest the additional features recited in claims 29-41 and 43-55. Instead, Suzuki '274 discloses the system for updating transaction history, as described above.

Further, there is no motivation to combine features related to the software vending machine of Suzuki '171 with the timed-access system of Peterson or the transaction updating system of Suzuki '274, nor has the Office Action established sufficient motivation or a *prima facie* case of obviousness. Even assuming that motivation to combine the applied references is established, the combination fails to teach or suggest Applicant's claimed features.

For at least these reasons, Applicant respectfully asserts that independent claim 28 is now patentable over the applied references. The dependent claims are likewise patentable over the applied references for at least the reasons discussed as well as for the additional features they recite.

Consequently, all the claims are in condition for allowance. Thus, Applicant respectfully requests that the rejections under 35 U.S.C. §§102 and 103 be withdrawn.

#### **IV. Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:GWT/gwt

Attachment:  
Petition for Extension of Time

Date: April 30, 2004

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